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September 27, 2005

VIA FIRST CLASS MAIL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

09-30-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #1

Re: House of Blues Brands Corp. v. Celebrites Publishing Corporation
TTAB Opp. No. 91,165,876
Serial No. 78/441,156

Dear Commissioner:

We enclose for filing an original of Applicant's Reply in Support of Motion to Dismiss for Failure to State a Claim Upon Which Can Be Granted Pursuant to FRCP 12(b)(6).

Please indicate receipt of this Motion by stamping the enclosed pre-paid postage postcard, and return it to our office at the address on the letterhead above. Thank you.

Very truly yours,

Chad M. Iida

Enclosure

cc: Akin Gump Strauss Hauer & Feld LLP (Via First-Class Mail)

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a).

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on:

9/27/2005
Date

Chad M. Iida

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/441,156
Filed June 24, 2004
Mark IN ROCK WE TRUST
Published on June 7, 2005

House of Blues Brands Corp.,
Opposer,

v.

Celebrites Publishing Corporation,

Applicant.

Opposition No. 91,165,876

APPLICANT'S REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED PURSUANT TO F.R.C.P. 12(b)(6); DECLARATION OF COUNSEL; EXHIBIT "A"; CERTIFICATE OF SERVICE

APPLICANT'S REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED PURSUANT TO F.R.C.P. 12(b)(6)

Applicant Celebrites Publishing Corporation ("Celebrites" or "Applicant"), by and through its undersigned attorneys, pursuant to 37 CRF 2.127(a) and T.B.M.P. § 502.02(b), submits this Reply in Support of its Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted. Celebrites files this Reply to rebut arguments raised in Opposer House of Blues Brands Corp.'s Response to Applicant's Motion to Dismiss dated September 13, 2005 (the "Opposer's Response").

I. ARGUMENT

A. The Opposer's Mark and Applicant's Mark Are Not Similar Even Though They Both Include Terms That Have A Musical Reference

In its Response, Opposer argues that the Applicant's IN ROCK WE TRUST mark and the Opposer's IN BLUES WE TRUST mark are similar in that both marks describe a style of music. Opposer's Response at 4 & 7. This argument appears to be an attempt by the Opposer to monopolize the IN _____ WE TRUST marks where the "_____" contains a musical reference. The Opposer, however, does not have rights to the entire music genre simply because its mark relates to only one of the many styles and forms of music.

The courts have previously rejected this argument in the context of comparing goods and services, and have found that not all musically related goods and services are alike. For instance, in *Suneblick v. Harrell*, 895 F.Supp. 616, 38 USPQ2d 1716 (S.D.N.Y. 1995), the court found that musical recordings for jazz records were different from musical recordings for rap albums. See also, *Q Division Records, LLC v. Q Records*, 2000 U.S. Dist. LEXIS 1773, 2000 WL 294875, at *4 (D.Mass. Feb. 11, 2000) (Stating that although both parties sold musical recordings "that is not the end of the matter, since this type of classification is so broad as to be meaningless.").

Similarly, in *M2 Software, Inc. v. M2 Communications, LLC*, 281 F.Supp.2d 1166 (C.D.Cal. 2003), the court held that the plaintiff's music royalty tracking services and products were not related to defendant's Christian music products. And, in *Richards v. Cable News Network, Inc.*, 15 F.Supp.2d 683 (E.D.Penn. 1998), the court ruled that the defendant's television feature program covering music news from around the world was not similar to plaintiff's pre-recorded audiotapes, records and CD's for music.

These cases clearly demonstrate two things. First, while the parties' goods and services may have had a musical reliance in general, they did not have the same specific reliance on music to confuse the public as to the source of the goods and services. Second, although a party's goods and services related to music, that party could not monopolize all musically related goods and services and prevent another party from using a mark that relates to a different style or genre of music. Here, although ROCK and BLUES may have a general musical reliance, they refer to two separate and distinct genres of music which eliminates any possibility that the public would confuse Applicant's IN ROCK WE TRUST mark with the Opposer's IN BLUES WE TRUST mark.

While the Opposer would like the Board to believe that there are no other registered IN _____ WE TRUST marks that have a similar musical reference (Opposer's Response at 6), Applicant points out that the IN HOUSE WE TRUST mark (Reg. No. 2878675) has a musical reference to "house music." See, a true and accurate copy of the Merriam-Webster Online dictionary for the definition of the term "house", attached as Exhibit "A," defining "house" as "a type of dance music mixed by a disc jockey that features overdubbing with a heavy repetitive drumbeat and repeated electronic melody lines." Applicant respectfully requests the Board to take judicial notice of this dictionary reference.[1] Consequently, the Opposer's assertions that it has cornered the IN _____ WE TRUST market where the "_____" has a musical reliance, fails on its face. The registration for IN HOUSE WE TRUST supports the conclusion that the public would not be confused as to the source of the Applicant's and the Opposer's goods and services simply because both marks include terms that refer to music.

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[1] The Board has indicated that judicial notice of dictionary definitions is proper. See, *In re Dodd International, Inc.*, 222 USPQ 268 (TTAB 1983); *In re Canron, Inc.*, 219 USPQ 820 (TTAB

B. Discovery Is Not Necessary Because There Are No Genuine Issues As To Any Fact That Would Be Material To A Determination Of Likelihood Of Confusion And Dilution.

In Opposer's Response, Opposer attempts to create a fiction that the evidentiary record needs to be developed before the Board can make a determination of likelihood of confusion and dilution. Opposer's Response at 7-9. However, that is not the case in deciding this Motion.

In *Kellogg Co. v. Pack'em Enterprises Inc.*, 21 USPQ2d 1142, 1145 (Fed Cir. 1991), the Federal Circuit affirmed the Boards ruling that a single *du-Pont* factor could be dispositive of the likelihood of confusion issue. In that case, the Board held that the marks FROOT LOOPS and FROOTEE ICE and design "differ so substantially in appearance, sound, connotation and commercial impression that there is no likelihood that their contemporaneous use by different parties will result in confusion." *Id.* at 1144. The Board stated that it would reach this conclusion:

> even if opposer offered evidence at trial establishing that it has made prior and continuous use of its mark on goods, such as fruit-flavored frozen confections, which are very closely related to the goods identified in the applicant's application; that the goods move through the same channels of trade to the same classes or purchasers; that the goods are purchased casually rather than with care; and that opposer's mark "FROOT LOOPS" has become a very strong and well known, indeed, famous, mark as applied to its goods on commerce. . .The first *Dupont* factor simply outweighs all of the others which might be pertinent to this case. Accordingly, we believe that there is no genuine issue as to any fact that would be material to our decision on the question of likelihood of confusion, and that applicant is entitled to judgment on this question as a matter of law.

Id. See also, *W.L. Gore & Associates Inc. v. Johnson & Johnson*, 36 USPQ2d 1552 (Del. 1995) (Similarity of marks is one of most probable and critical elements in confusion

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1983); TBMP §§ 712 et seq.

analysis; the marks GLIDE and EASY SLIDE, both for dental floss, are dissimilar in both appearance and sound thus tipping balance against finding of likelihood of confusion).

Here, even if Opposer could show through discovery that it has made prior and continuous use of its mark, that the Applicant's and Opposer's goods move through similar channels of trade to the same classes or purchasers, that the goods are purchased casually rather than with care, and that Opposer's mark is strong and famous, the Applicant's mark is so substantially different from the Opposer's mark in terms of sight, sound and commercial impression that confusion is unlikely as a matter of law. Accordingly, discovery in this case is not necessary to a determination of a likelihood of confusion or dilution, and there are no genuine issues of material fact that should preclude the granting of Applicant's Motion to Dismiss. This is especially true since the Applicant's mark is an intent-to-use mark, and a statement of use has not yet been filed; therefore, there will be no evidence relating to any actual confusion that can be presented in this case. *Ziebart International Corp. v. After Market Associates, Inc.*, 802 F.2d 220, 226, 231 USPQ 119, 125 (7th Cir. 1986) (Similarity of marks, evidence of actual confusion and intent of the defendant are the three most important factors in the likelihood of confusion analysis).

C. Opposer's IN BLUES WE TRUST Mark Is Not Distinctive For Dilution Purposes.

Opposer has argued that its IN BLUES WE TRUST mark is distinctive for purposes of dilution because it is incontestable and has been registered on the Principal Register. Opposer's Response at 6-8. If the Opposer's argument is taken as true, then six

of the registered marks that include the phrase IN _____ WE TRUST cited in the Applicant's Brief in Support of its Motion to Dismiss ("Brief in Support of Motion"), p.p. 12-13, are also distinctive for purposes of dilution, and therefore, establish public recognition of numerous uses of the phrase IN _____ WE TRUST.[2] In fact, two of the six incontestable marks for the phrase IN _____ WE TRUST have been renewed for registration on the Principal Register for 10 years.[3] These various other incontestable registrations show that the phrase IN _____ WE TRUST is not "so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1177 (TTAB 2001); *Hasbro Inc. v. Clue Computing Inc.*, 66 F.Supp2d 117, 132, 52 USPQ2d 1402, 1413-14 (D.Mass. 1999) ("[M]arks consisting of relatively common terms and with use of the same terms by third parties. . .not sufficiently famous to warrant FTDA protection"); *Syndicate Sales Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 640, 52 USPQ2d 1035, 1041 (7th Cir. 1999); *Star Markets, Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030 (D. Haw. 1996).

Not only does the Opposer's argument show that the Opposer's mark is not vulnerable to dilution, but it also belies the Opposer's argument that third party registrations are afforded little weight in a likelihood of confusion analysis. If incontestable marks are so highly "distinctive" as the Opposer argues, then the public would recognize, based on the third party incontestable IN _____ WE TRUST marks, that different goods and services identified by that phrase have different origins, and

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[2] U.S. Reg. Nos. 2117541, 2117541, 2231755, 2320744, 1799536 and 1203148.
[3] U.S. Reg. Nos. 1799536 and 1203148.

would look to features other than the phrase IN _____ WE TRUST to distinguish the Opposer's mark from others – in this case, to BLUES and ROCK. See, Applicant's Brief in Support of Motion at 10-14. As a result, the public would not confuse the Applicant's ROCK-containing mark with the Opposer's BLUES-containing mark since ROCK and BLUES are significantly different in terms of appearance, sound and commercial impression. Compare, *American Hospital Supply Corp. v. Air Products and Chemicals, Inc.*, 194 USPQ 340, 343 (TTAB 1977) (Third party registrations "are competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore inclusion of [the common element] in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity"); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988).

II. CONCLUSION

Opposer's Notice of Opposition should be dismissed in its entirety because (1) there is no likelihood of confusion between Applicant's and Opposer's marks given the dissimilarity of the marks and the goods/services under the respective marks; (2) Opposer's Notice of Opposition is legally insufficient in that it does not allege when its marks became famous; (3) Opposer's marks are not famous or distinctive to raise a dilution claim; and (4) Applicant's mark does not dilute Opposer's marks.

DATED: Honolulu, Hawaii, September 27, 2005.

By: Chad M. Iida

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CERTIFICATE OF MAILING UNDER 37 CFR 2.197

I hereby certify that this correspondence is being mailed prior to the expiration of the set period of time by being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on:

9/27/2005
Date

Chad M. Iida
Chad M. Iida

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/441,156
Filed June 24, 2004
Mark IN ROCK WE TRUST
Published on June 7, 2005

House of Blues Brands Corp., Opposer, v. Celebrites Publishing Corporation, Applicant.	Opposition No. 91,165,876 DECLARATION OF COUNSEL

DECLARATION OF COUNSEL

I, Chad M. Iida, declare as follows:

1. I am associated with the firm of Godbey Griffiths Reiss Chong, LLLP, and submit this declaration herein in support of Applicant Celebrites' Reply in Support of Motion to Dismiss For Failure To State A Claim Upons Which Relief Can Be Granted Pursuant To FRCP 12(b)(6).

2. Attached as Exhibit "A" is a true and accurate copy of the Merriam-Webster OnLine Dictionary entry for the word "house."

I declare under the penalty of perjury that the foregoing is true and correct.

DATED: Honolulu, Hawaii, September 27, 2005.

Chad M. Iida

HOME
PREMIUM SERVICES
M-WCollegiate.com
M-WUnabridged.com
Britannica.com
Multi-User Licenses
DOWNLOADS
WORD OF THE DAY
WORD GAMES
WORD FOR THE WISE
ONLINE STORE
HELP

Merriam-Webster Inc.
Company information

Merriam-Webster Online Dictionary

Thesaurus

87 entries found for **house**. The first 10 are listed below.
To select an entry, click on it. For more results, click here.

house[1,noun] Go
house[2,verb]
House
apartment house
art house
bawdy house

Main Entry: [1]**house**
Pronunciation: 'haus
Function: *noun*
Inflected Form(s): *plural* **hous·es** /'hau-z&z *also* -s&z/
Usage: *often attributive*
Etymology: Middle English *hous,* from Old English *hus;* akin to Old High German *hus* house

1 : a building that serves as living quarters for one or a few families **:** HOME
2 a (1) **:** a shelter or refuge (as a nest or den) of a wild animal (2) **:** a natural covering (as a test or shell) that encloses and protects an animal or a colony of zooids **b :** a building in which something is housed <a carriage *house*>
3 a : one of the 12 equal sectors in which the celestial sphere is divided in astrology **b :** a zodiacal sign that is the seat of a planet's greatest influence
4 a : HOUSEHOLD **b :** a family including ancestors, descendants, and kindred <the *house* of Tudor>
5 a : a residence for a religious community or for students **b :** the community or students in residence
6 a : a legislative, deliberative, or consultative assembly; *especially* **:** one constituting a division of a bicameral body **b :** the building or chamber where such an assembly meets **c :** a quorum of such an assembly
7 a : a place of business or entertainment **b** (1) **:** a business organization <a publishing *house*> (2) **:** a gambling establishment **c :** the audience in a theater or concert hall <a full *house* on opening night>
8 : the circular area 12 feet in diameter surrounding the tee and within which a curling stone must rest in order to count
9 : a type of dance music mixed by a disc jockey that features overdubbing with a heavy repetitive drumbeat and repeated electronic melody lines
- **house·ful** /'haus-"ful/ *noun*
- **house·less** /'hau-sl&s/ *adjective*
- **house·less·ness** *noun*
- **on the house :** without charge **:** FREE

EXHIBIT A

For **More Information on "house" go to Britannica.com**

Get the **Top 10 Search Results for "house"**

Pronunciation Symbols

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

House of Blues Brands Corp., Opposer, v. Celebrites Publishing Corporation, Applicant.	Opposition No. 91,165,876 CERTIFICATE OF SERVICE

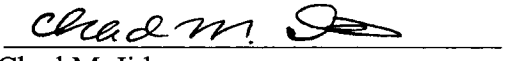
CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED PURSUANT TO FRCP 12(b)(6); DECLARATION OF COUNSEL; EXHIBIT "A", and this CERTIFICATE OF SERVICE were duly served upon Opposer by first class mail, postage prepaid, on September 27, 2005 to its last known address set out below:

Kirt S. O'Neill
Marissa Lawson
Akin Gump Strauss Hauer & Feld LLP
P.O. Box 12870
San Antonio, Texas 78212

Attorneys for Opposer

DATED: Honolulu, Hawaii, September 27, 2005.

By: 

Chad M. Iida
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